

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/001,442 Confirmation No. 2397
Appellant : Mike SHELDON, *et al.*
Filed : October 31, 2001
Group Art Unit: 2179
Examiner : Ba Huynh
Title : METHOD AND SYSTEM FOR RENDERING DISPLAY
Docket No. : MFCP.81059
Customer No. : 45809

VIA EFS – 22 September 2008

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Commissioner for Patents
P.O. Box 1450
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APPELLANT'S REPLY BRIEF

Dear Sir:

This is a Reply Brief in response to an Examiner's Answer mailed 22 July 2008. These claims have been at least twice rejected. Appellants do hereby submit this Reply Brief under 37 C.F.R. §41.41(b)(2). The Commissioner is hereby authorized to charge any additional fee that may be due, or credit any overpayment, to Deposit Account No. 19-2112.

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I. STATUS OF CLAIMS

Claims 1, 3-9, and 11-14 are pending, and the rejection of each of those claims is being appealed. Claims 2, 10, and 15-16 are canceled.

II. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A) Whether claims 1, 3-9, and 11-14 are unpatentable under 35 U.S.C. § 103(a) over Rodden *et al.* (US Patent No. 6,473,102) and Buote *et al.* (US Patent No. 6,581,020).

B) Whether claims 4, 11, and 14 are unpatentable under 35 U.S.C. § 103(a) over Rodden *et al.* (US Patent No. 6,473,102), Buote *et al.* (US Patent No. 6,581,020), and Hatori *et al.* (US Patent Publication No. 2002/0075289).

III. ARGUMENT

The Office has included several additional explanations in the 22 July 2008 Examiner's Answers to shore up the original grounds of rejection maintained in the 26 December 2006 Final Office Action. In summary, the Office's additional arguments are: Appellant's resolution threshold is only a manufactured display device resolution; Rodden implicitly suggests a resolution threshold; Rodden's preferred size is the claimed specified size; Buote's window size is defined by a property of the window; Buote defines a resolution threshold; the combination of Rodden and Buote provides the advantage of recalculating and changing of window size only when the resolution threshold is reached instead of every time the resolution threshold changes; and Hatori teaches that a restore button is "well-known."

Appellant addresses each explanation in the remarks that follow. Appellant concludes that the prior art, including Rodden, Buote, and Hatori fails to render the invention of claims 1, 3-9, and 11-14 unpatentable because the prior art fails to describe or suggest all elements of independent claims 1, 7-11, and 14. Accordingly, Appellant is entitled to a patent because the invention meets all the statutory criteria for patentability.

A) Rejection under 35 U.S.C. § 103(a) over US Patent No. 6,473,102 in view of US Patent No. 6,581,020.

Claims 1, 3-9, and 11-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,473,102 ("Rodden") in view of US Patent No. 6,581,020 ("Buote"). Appellant respectfully traverses this rejection, as hereinafter set forth.

The Office contends that “pre-determined threshold value” as used in independent claim 1 is undefined. The Office concludes that Appellant’s resolution threshold is only a manufactured display device resolution. *See, Examiner’s Answer mailed 22 July 2008 at pp. 10-11.* The Office cites Appellant’s specification, at pp. 12-13, to support this conclusion.

Appellant respectfully disagrees. During examination, the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *See, Manual of Patent Examination Procedure (MPEP) §2111.01 (2007).* The plain meaning of “pre-determined threshold value” as used in independent claim 1 is a screen resolution threshold that is determined beforehand. This meaning is consistent with Appellant’s specification, at pp. 12-13, which describes exemplary display devices that are configured with display resolutions ranging from “800X600” to “1024X768.” This portion of Appellant’s specification describes a range of values for the resolution threshold and identifies one embodiment of the invention, where the value of the resolution threshold is 800X600. Nothing in the independent claim, the specification, or the prosecution history requires the resolution threshold to be only a manufactured display device resolution and not arbitrarily selected. Appellant respectfully requests that during patent examination, the Office use the broadest reasonable interpretation consistent with the specification. *Id.* Because Appellant has not attempted to be a lexicographer with respect to the term “pre-determined threshold value,” the broadest reasonable interpretation consistent with the specification is the plain meaning of the term “pre-determined threshold value.”

(i) Claims 1 and 5-7

The Office contends that Appellant misreads the Office's articulation of the scope and content of Rodden as applied against independent claim 1. *See, Examiner's Answer mailed 22 July 2008 at p. 16.* Additionally, the Office suggests that Rodden's disclosure, at col. 1, ll. 22-37; col. 4, ll. 57-59; and col. 5, ll. 33-40, allows one of ordinary skill in the art to infer that there is a threshold for resolution such that changing the resolution beyond this threshold would result in undesirable window views. *See, Id. at p. 8.*

The Office contends that the following statement of the scope and content of Rodden is inaccurate: "[t]he Office concedes that Rodden fails to teach the claimed requirement of automatically maximizing the size of the window. *See, Office Action mailed 26 December 2006 at page 3.*" Appellant respectfully notes that this statement is not a direct quote from the Office Action. It is merely Appellant's summary of the statement referred to in the Office Action. Moreover, Appellant provides a citation to the Office Action to support Appellant's summary. Appellant respectfully submits that the "See" introductory signal was used as part of the citation to the record to indicate that the statement made was not a direct quote. Accordingly, Appellant respectfully submits that Appellant's statement faithfully and honestly reflects the statements in the record. *See Examiner's Answer mailed 22 July 2008 at p. 9.*

The Office contends that Rodden's disclosure implicitly suggests a resolution threshold as required by independent claim 1. Contrary to the Office's assertion, Rodden's disclosure does not support an inference of a resolution threshold. Rather, Rodden's disclosure states whenever a window of interest is moved or the configuration of the display changes, the size and position of the window is calculated. *See, Rodden at*

FIG. 4 and col. 4, ll. 20-22. If a window is associated with a “keep visible” preference, Rodden calculates the position and resizes the window to include a number process executing on the computer display. If the resized window is within a rectangle of the display screen, the size does not need to be recalculated. *See, Rodden at col. 5, ll. 23-40.* Rodden does not expressly or implicitly use a resolution threshold when calculating the size and position. A resolution threshold is not used because moving the window does not require a change in resolution. A user may intentionally or accidentally position the window in an area of the display that reduces visibility of all content associated with the current window. Thus, the degree of overlap of the window and area within the rectangle is used by Rodden to resize and reposition the window. The rectangle described by Rodden does not implicitly suggest a predetermined resolution threshold. Moreover, Rodden does not use the term “threshold.” Accordingly, there is no explicit or implicit suggestion of a resolution threshold in Rodden’s disclosure as required by independent claim 1.

The Office contends Rodden’s preferred size is the specified size recited in independent claim 1. *Examiner’s Answer mailed 22 July 2008 at p. 15.* Additionally, the Office contends that the Appellant’s argument requires a “user” to designate a size for the window. *Id.*

Appellant respectfully disagrees. Rodden discloses a preferred size but not a specified size. The preferred size is “the size necessary to illustrate all content of the window without the need for scrollbars.” *Rodden at col. 5, ll. 3-5.* The preferred size is calculated in response to an event such as change in resolution or window movement. *See, Rodden at col. 4, ll. 20-30.* The plain and ordinary meaning of specified size—as

used in the context of independent claim 1—is a fixed window size. This meaning is consistent with Appellant’s specification at p. 12. Appellant’s specification describes the specified size to be a size that allows the window to be only a certain size. Rodden’s preferred size is not a specified size as required by independent claim 1. Accordingly, Rodden fails to teach or suggest the specified size.

Appellant’s argument in the Appeal Brief does not require user designation of a window size. *See, Appeal Brief mailed on 29 April 2008 at p. 16.* It is clear from Appellant’s arguments that the phrase “user selectively specifies certain windows to be displayed at a specified size and position” is a direct quote from the Office Action mailed 26 December 2006 at page 8. This phrase was not an argument that was introduced by Appellant. Rather, it was an argument proffered by the Office. In the Appeal Brief, Appellant respectfully rebutted the Office’s response. Accordingly, Appellant maintains that user designation of window size is not required by independent claim 1.

Appellant maintains that Rodden fails to disclose, teach, or suggest windows that are rendered in a nonmaximized state at a specified size and position when the window size and position are specified as required by independent claim 1. In other words, when the window properties for size and position are set, the window properties are fixed and are used to render the window.

Unlike the invention of independent claim 1, Rodden allows resizing of the window once a change in resolution occurs or the window is moved outside of the display area. Moreover, the size of the window is recalculated so that the size is set to illustrate all content of the window without the need for scroll bars. *See, Rodden at col. 5, ll. 3-5.* Accordingly, Rodden fails to disclose, teach, or suggest rendering a window in

a non-maximized state at a specified size and position when the window size and position are specified as required by independent claim 1.

The Office contends that support for “wherein the resolution does not change” as recited in independent claim 1 is not supported by Appellant’s specification. *See, Examiner’s Answer mailed 22 July 2008 at p. 17.* Alternatively, the Office contends that Rodden’s disclosure describes or teaches this element of independent claim 1.

Appellant respectfully disagrees. Appellant’s specification at p. 12 supports “wherein the resolution does not change” as recited in independent claim 1. Appellant’s specification shows that Appellant had possession of the claimed subject matter at the time of filing; not an *ipsis verbis* recitation of the claim language. *See* MPEP § 2163(II)(A) (2007).

Here, Appellant’s specification, at page 12, states the computer determines if the window is one capable of maximization when only default parameters are specified or no size and position are specified for the window. If the window is capable of maximization, the computer determines if the screen resolution is below the predetermined maximize threshold. If the screen resolution is below the threshold value, the window is automatically maximized. In Appellant’s specification, the window is automatically maximized without changing the screen resolution. There is no need for a change in screen resolution to trigger maximizing of the window because maximization of the window occurs when the computer determines the size and positions of the window are unspecified or set to default parameters. Accordingly, at the time of the invention of independent claim 1, Appellant had possession of window maximization without a change in screen resolution.

Contrary to the Office's assertion, Rodden, at col. 1, ll. 40-43; and col. 3, l. 50-col. 4, l. 15, does not teach, describe, or suggest changing from a first display device to a second display device, where the resolution remains the same. The cited portions describe switching from a LCD monitor to a notebook monitor—having different operating parameters—changes the size and position of the windows because the change in monitors effectively changes the display resolution. Accordingly, Rodden fails to teach, describe, or suggest “wherein the resolution does not change” as recited in independent claim 1.

The Office contends that Buote in combination with Rodden teaches, describes, or suggests the elements of the independent claim 1 that Rodden fails to teach, describe, or suggest. The Office contends Buote's window size is defined by a property of the window. *See Examiner's Answer mailed 22 July 2008 at p. 12.* Also, the Office contends that Appellant's statement that “in Buote all windows are the same size without regard to screen resolution” is unsupported. *Id.*

Appellant respectfully disagrees. Buote does not expressly state that the size of the window is defined in the property of the window. Moreover, whether it is possible to specify a different size using a property of the window is a moot point. The point is Buote expressly states that all screens (windows) are at 600 pixels by 800 pixels. *Buote at col. 11, l. 15.* A change in screen resolution to a resolution higher than 600 pixels by 800 pixels causes the computer system to prevent the windows from appearing in maximized mode. The window is in “window mode” because the current screen resolution is larger than the size (600 pixels by 800 pixels) of the window. However, at resolutions equal to 600 pixels by 800 pixels, the windows will appear in “maximized

mode” meaning because the screen resolution and window size are the same. In context, lines 15 through 21 of column 11 in Buote clearly discloses the size of each screen (window) is 600 pixels by 800 pixels. Accordingly, Buote clearly supports Appellant’s statements that in Buote all windows are the same size without regard to resolution.

The Office contends that Appellant’s statement in Appellant’s Brief, at p. 14, ll. 16-17, that Buote fails to teach, describe, or suggest altering window size because all windows are set to 600 pixels by 800 pixels contradicts an alleged admission in Appellant’s Brief, at pp. 12 -13. *See Examiner’s Answer mailed 22 July 2008 at pp. 13-14.*

Appellant respectfully disagrees. Appellant’s Brief, at pp. 12-13, states the size of the windows is set to 600 pixels by 800 pixels . There is nothing in Appellant’s Brief that admits or otherwise states that Buote’s windows alter their size when a “resolution threshold” is crossed. Rather, the cited portions of Appellant’s brief expressly state that Buote does not teach, describe, or suggest selectively altering the size of the window based on screen resolution. These passages of Appellant’s brief are entirely consistent with the interpretation of Buote and the other sections of Appellant’s Brief. Appellant is unable to locate the contradiction identified by the Office.

The Office contends that Buote teaches, describes, or suggests a screen resolution threshold as required by independent claim 1. *Examiner’s Answer mailed 22 July 2008 at pp. 8-9.*

Contrary to the Office’s conclusion, Buote does not describe a screen resolution threshold. Specifically, column 11 of Buote describes the user interface for reporting laboratory data. In lines 4-15 of column 11, the term “screen” is used to represent

window. Buote states “each screen shares the following common areas: title bar 127, menu bar 128, info area 131, caption 133, etc.” These areas of the screen represent areas of the window. FIG. 4 illustrates the screen/window described by Buote. Moreover, Buote states all screens are at 600 pixels by 800 pixels resolution meaning all windows are at 600 pixels by 800 pixels resolution. This means that each window is sized to be 600 pixels by 800 pixels. The discussion in lines 15 through 30 of column 11 describes the display modes: window mode and a maximized mode. Maximized mode is when the display resolution is at 600 by 800, which means the windows appear maximized because all windows are sized to be 600 by 800. Window mode is when the display resolution is higher than 600 by 800 pixels, which means windows will appear nonmaximized when sized at 600 by 800 pixels because the window size (600 by 800) is set to be smaller than the current display resolution. Buote fails to teach, describe, or suggest a threshold for display resolution as required by independent claim 1.

Moreover, Buote fails to use the term “threshold.” In Buote, all screens remain the same size, 600 pixels by 800 pixels. The current display resolution for the computer may change to be more than 600 pixels by 800 pixels and when that occurs, the window will remain sized to 600 pixels by 800 pixels and will not be resized. *See Buote at col. 11, ll. 15-20.* Accordingly, Appellant respectfully submits that Buote does not disclose, describe, or suggest a screen resolution threshold as required by independent claim 1.

The Office contends Rodden in combination with Buote teaches, describes, or suggests comparing screen resolution against a predetermined threshold value and automatically maximizing the size of the window on a display screen when the screen

resolution is below the predetermined threshold value as recited in claim 1. *Examiner's Answer mailed 22 July 2008 at p. 10.*

As discussed above, neither Buote or Rodden expressly recite the term "threshold." Moreover, Rodden does not implicitly suggest a screen resolution threshold. Additionally, Rodden in combination with Buote does not implicitly teach, describe, or suggest a screen resolution threshold or comparing the current screen resolution to a screen resolution threshold and maximizing windows having unspecified sizes and positions without changing the current screen resolution as required by independent claim 1. At best, Buote describes rendering windows in maximized mode or window mode based on the current screen resolution. Thus, even if combined, Rodden and Buote fail to teach, describe, or suggest all elements of independent claim 1.

The Office contends the rationale is to combine the idea of resolution threshold to resize the window only when the threshold is reached, not integrate Buote's entire system into Rodden's system. *Examiner's Answer mailed 22 July 2008 at pp. 10 and 12-13.*

The Office uses impermissible hindsight to arrive at this rationale. See, *MPEP §2141.01(III)(2007)*. At the time of the invention, the prior art (Rodden and Buote) did not teach, describe, or suggest, among other things, a screen resolution threshold, comparing the current screen resolution to a screen resolution threshold, and maximizing windows having unspecified sizes and positions without changing the current screen resolution as required by independent claim 1. Accordingly, Buote and Rodden fail to support a *prima facie* case of obviousness for the invention of independent claim 1.

(ii) Claim 3

The Office contends that Appellant's specification at p. 12 describes the elements of claim 3 as being conventional and "well known." See, *Examiner's Answer mailed 22 July 2008 at p. 17*. Also, the Office contends that Buote describes the elements of claim 3.

Appellant respectfully disagrees. The Office should treat Appellant's specification as the work of Appellant in the absence of a credible explanation. See, *MPEP §2129(I) (2007)*. Here, the Office incorrectly looks to Appellant's specification in the detailed description of the invention and characterizes Appellant's description of the invention of claim 3 as well-known, conventional, and "prior art." As described at pages 12 through 13 of Appellant's invention, in accordance with Appellant's invention, when a window is specified to have a specified size and position; maximization is not allowed. Further, Appellant's specification describes an instance where an author specifies the size to be only one size to prevent maximization. This is Appellant's specification of the invention and not admitted prior art. Accordingly, Appellant requests that the Office's suggestion at page 17 of the Examiner's Answer with regard to what is admitted prior art in Appellant's specification not to be treated as such.

Moreover, contrary to the Office's suggestion, Buote does not teach, describe, or suggest windows that are incapable of maximization based on whether a size and position are specified or unspecified as required by the invention of claim 3. As discussed above Buote describes only one size and fails to describe nonmaximization of windows based on whether a size and position are specified. Accordingly, Appellant respectfully submits that Rodden and Buote fail to teach, describe, or suggest all elements of claim 3.

(iii) Claims 8, 12, and 13

The Office contends that separate consideration of claims 8, 12, and 13 is unnecessary because in the Appeal Brief, Appellant repeats the same arguments for claims 1 and 8, 12, and 13. *See Examiner's Answer mailed 22 July 2008 at p. 19.*

Appellant respectfully disagrees. The Appeal Brief does not repeat the same arguments for claims 8, 12, and 13. These claims are grouped separately from claim 1 because they differ in scope from claim 1 and require a different analysis. For instance, claim 1 indicates the threshold value is predetermined whereas claim 8 notes that the screen resolution threshold is selected. Appellant respectfully notes that a predetermined resolution threshold is not the same as a selected resolution threshold. Therefore, claims 1 and 8, 12, and 13 require separate consideration for patentability. Accordingly, Appellant in the Appeal Brief addresses each of these claims independently and provides independent arguments for the claims. It appears that the Office has not adequately addressed Appellant's concerns with respect to claims 8, 12, and 13. Accordingly, Appellant respectfully requests independent consideration of claims 8, 12 and 13.

B) Rejection under 35 U.S.C. § 103(a) over US Patent No. 6,473,102 in view of US Patent No. 6,581,020 and US Patent Publication No. 2002/0075289.

The Office correctly identifies that Appellant erroneously states the restore button limitation is recited in claims 1, 8, and 14. *See, Examiner's Answer mailed 22 July 2008 at p. 13.*

Appellant intended to state that the claimed invention is patentable over Rodden and Buote because the references do not teach the following elements of the claimed invention: (1) maximizing a window when the size and position are not specified and the screen resolution is below a predetermined threshold as recited in claims 1 and 8; and (2)

reducing the size of the maximized window by a predetermined amount when a restore button on the maximized window is initiated as recited in claim 14. Appellant erroneously stated that elements (1) and (2) were recited in claims 1, 8 and 14. Appellant meant element (1) was recited in claims 1 and 8 and element (2) was recited in claim 14.

(i) Claim 4

Appellant respectfully notes that the Office for the first time relies upon a previously cited, but unapplied, patent publication to support the argument of obviousness. *See, Examiner's Answer mailed 22 July 2008 at pp. 17-18.*

“A new prior art reference applied or cited for the first time in an [E]xaminer's [A]nswer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (C.C.P.A. 1970).” *MPEP §1207.03(III) (2007)*. *See also Ex parte Movva*, 31 USPQ2d (BNA) 1027 (BPAI 1993).

Appellant has challenged the Office's statement that a “restore button” is “well-known” since April 2006. Appellant submits that the Office has impermissibly included a new ground of rejection. Even if this ground of rejection is proper, Hatori fails to teach, describe, or suggest the restore button as recited in claim 4. Hatori merely describes a zoom feature, which does not reduce the size of the window by a predetermined amount as required by claim 4. Accordingly, Hatori does not clearly support the Official Notice taken by the Office. Hatori should not be a reference that the Office can rely on because

it materially changes the grounds for rejection finalized by the Office. Nevertheless, if Hatori is relied on, Hatori does not teach reducing the size of the window by a predetermined amount based on the selection of the restore button. Accordingly, Applicant requests withdrawal of the rejection and allowance of claim 4.

(ii) Claim 11

The Office contends that separate consideration of claim 11 is unnecessary because in the Appeal Brief, Appellant repeats the same arguments for claim 11 and claim 4. *See Examiner's Answer mailed 22 July 2008 at p. 19.*

Appellant respectfully disagrees. The Appeal Brief does not repeat the same arguments for claim 11. This claim is grouped separately from claim 4 because it differs in scope from claim 4 and requires a different analysis. For instance, claim 4 recites determining whether a restore button has been initiated, whereas claim 11 recites determining whether a restore button has been initiated if the window has been maximized. Here, the condition in claim 11 is not present in Claim 4. This renders the scope of the claims different. Therefore, claim 11 requires separate consideration for patentability. Accordingly, Appellant in the Appeal Brief addresses each of these claims independently and provides independent arguments for the claims. It appears that the Office has not adequately addressed Appellants concerns with respect to claim 11. Accordingly, Appellant respectfully requests independent consideration of claim 11.

(iii) Claim 14

The Office contends that separate consideration of claim 14 is unnecessary because in the Appeal Brief, Appellant repeats the same arguments for claims 14 and claims 1 and 4. *See Examiner's Answer mailed 22 July 2008 at p. 19.*

Appellant respectfully disagrees. The Appeal Brief does not repeat the same arguments for claim 14. This claim is grouped separately from claims 1 and 4 because it differs in scope from claims 1 and 4 and requires a different analysis. For instance, claim 14 recites the restore button is created with the window, whereas claim 4 does not have a condition for the time at which the restore button is created on the window. This renders the scope of the claims different. Therefore, claim 14 requires separate consideration for patentability. Accordingly, Appellant in the Appeal Brief addresses each of these claims independently and provides independent arguments for the claims. It appears that the Office has not adequately addressed Appellants concerns with respect to claim 14. Accordingly, Appellant respectfully requests independent consideration of claim 14.

IV. CLOSING

Appellant respectfully submits that claims 1, 3-9, and 11-14 are in condition for allowance. As such, Appellant respectfully requests that the rejection of the claims be reversed and that a timely Notice of Allowance be issued in this case. Should there be any unresolved matters, please contact the undersigned.

Respectfully submitted,

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